

### **REMARKS**

In the above-mentioned office action, all of the pending claims, claims 1-9, were rejected under Section 102. The Examiner relied upon Figures 1-4 and pages 1-3 of the Applicants' disclosure, stated by the Examiner, to be the Applicants' admitted prior art to support the rejection of the claims. The Examiner further objected to Figures 1-4 of the drawings and stated that Figures 1-4 should be designated by a legend such as "prior art" because "only that which is old is illustrated".

Independent claims 1 and 6 have been amended, as set forth herein, in manners believed to distinguish better the cited invention over Figures 1-4 and pages 1-3 of the original disclosure. The rejection of the claims, as now-presented, is respectfully traversed. Specifically, the applicant traverses the Examiner's assertion that Figures 1-4 or pages 1-3 of the application disclose the setting of a configuration failure flag or of the sending of a configuration failure message after the cell update is completed if the configuration failure flag is set.

The Examiner asserted that it is inherent that a flag or an indicator is set in the user equipment to report to the UTRAN about a failed configuration procedure due to the occurrence of a cell update procedure.

There simply is no disclosure of a flag element or of its setting in Figures 1-4 or their corresponding description.

The Applicant believes the standard that is required to support the Examiner's inherency argument is that the characteristic claimed to be inherent must necessarily be required, not merely that the characteristic may be present. See, for example, MPEP Section 2112 and in *Rijckaert*, 9F.3d1531 (Fed. Cir. 1993) that is cited therein.

The disclosure of Figures 1-4 and pages 1-3 do not necessarily or inherently possess the characteristics of the claimed invention. A timer, for instance, might be used at the user equipment. The Applicant believes that a timer would be operable in a manner different than the setting of a configuration failure flag.

Therefore, Figures 1-4 and pages 1-3 are believed not to inherently show the setting of a configuration failure flag nor of the sending of a configuration failure after the cell update is completed if the configuration failure flag is set.

Claim 6 is analogously analyzed.

As the remaining ones of the dependent claims include all of the limitations of their parent claim, these claims are believed to be patentable for the same reasons as those given with respect to independent claims 1 and 6.

In light of the foregoing, therefore, independent claims 1 and 6, and dependent claims 2-3 and 5 are believed to be in condition for allowance. Accordingly, reexamination and reconsideration for allowance of these claims is respectfully requested. Such early action is earnestly solicited.

Respectfully submitted,

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